

R marks/Arguments

Claims 12 to 17 are pending. Support for the amendment to Claim 12 is found on page 5, line 1, for example. New Claim 16 is supported by page 4, lines 5 and 6. New Claim 17 is supported by page 5, lines 19 to 23.

The Title has been changed. The priority benefit paragraph has been updated.

The Office Action stated: that the priority data referring to application 09/461,313 is not accurate because the application has been issued; and that it is requested that applicants update the priority data. Applicants have updated the priority benefit paragraph.

The Office Action stated: that the title of the invention is not descriptive; that a new title is required that is clearly indicative of the invention to which the claims are directed; and that the following title is suggested: Process Of Making Lids Having An Embossed Sealing Layer. Applicant has inserted the suggested new Title for the old Title.

Claims 12 to 16 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Zuser et al. (WO 98/26931) in view of Hill (U.S. Patent No. 3,959, 546). Applicant traverses this rejection.

The Office Action stated that it is noted that the column and line listings for Zuser et al. are from the English translation of the document U.S. Patent No. 6,200,663.

Claim 12 has been amended to recite that the depth of the roughness of the roughness pattern of the surface configuration of the cooling roll is such that

such roughness does not penetrate through the sealing layer. This feature is an essential feature of applicant's claimed invention (and this feature is supported by page 5, lines 20 to 23, of the application.) The Substrate material on its free side must be smooth and not be embossed or having any roughness from the embossing process. To get to that result, the roughness of the roll must not penetrate into the rest of the lid.

The Office Action stated that, regarding Claim 12, Zuser et al. teaches the basic claimed process of making a lid having a roughened sealing layer, comprising: coating a substrate material with a layer to form a sealing (1:10-22 and 2:60-65); and embossing a coating/sealing layer between rolls to form a roughened sealing layer (3:10-18). Applicant traverses this statement as being an incorrect description of the disclosure of Zuser et al.

Zuser et al. does not disclose a two step process of first coating a substrate with a sealing layer and then embossing the coating/sealing layer between rolls to form a sealing layer. Instead, at best Zuser et al. uses a single step using a roller to simultaneously supply and a roughen film. Zuser et al. discloses that it uses a pressure roll to apply a sealing layer with simultaneous embossing of said sealing layer to form spacers 8 (i.e., roughness) therefrom. Zuser et al. does not disclose any other preparation process within the scope of its disclosed invention.

The Examiner's attempts to turn Zuser et al. into a two step preparation process has no factual support, and would destroy the very core of the disclosed

invention of Zuser et al. (which action is forbidden and has no basis or motivation for one ordinarily skilled in the art to do).

Zuser et al. does not disclose the use of a second roller, alone a second roll that is a cold roll. To try to read a second roll in or into the Zuser et al. disclosure is mere speculation. Silence in the disclosure of the Zuser et al. invention is no substitute for the facts required by Section 103(a).

Zuser et al. states:

“With the aid of an appropriately shaped pressure roll, an additional coating is applied to this coating so that the spacers 8 are formed in
geometrical arrangement on the side 3 of the surface that is turned toward the material to be packaged. In the process, the surface of the pressure roll exhibits depressions, for example, that correspond to the geometric arrangement as well as the shape of the spacers.” [Emphasis supplied]
[Column 3, lines 10 to 17]

“This packaging element according to FIG 3 can be produced in a process that is particularly easy to implement, due to the fact that with the aid of an appropriately shaped pressure roll, a coating is applied directly onto carrier material 5 so that the spacers 10 are produced.” [Emphasis supplied] [Column 3, lines 20 to 25]

“The pressure roll is formed to such a way that coating thickness of 1-30 um are possible, and owing to corresponding depression in the surface of the press roller, coating thickness of 4-100 um are possible at

geometrically arranged locations.” [Emphasis supplied] [Column 3, lines 26 to 30]

Zuser et al. only discloses the simultaneous coating and embossing of the sealing layer use an embossing roller (no second roller is ever mentioned).

Zuser et al. also states:

“These spaces 11 are produced on the layer 4 that carries the printed image in such a manner that with the aid of an approximately shaped pressure roll, a layer of printing ink is applied so that the spacers 11 are produced, for example in semicircular form.” [Emphasis supplied] [Column 3, lines 34 to 38]

Even when putting a layer of printing ink in space form on its outer layer. Zuser et al. only uses an approximately shaped pressure roll. No mention is made of a second roller.

Applicant embosses using an embossing cold roll. Zuser et al. does not mention a cold roll. Zuser et al. uses an embossing pressure roll. Needless to say, Zuser et al. directs one ordinarily skilled in the art away from applicants’ claimed process.

Column 1, lines 10 to 45, of Zuser et al. describes the prior art and its recited problems that are the very object and purpose the Zuser et al. invention seeks to overcome. One ordinarily skilled in the art has no reason to combine the Zuser et al. invention with the prior art and its recited disadvantages/problems that the Zuser et al. invention is stated to overcome. To stick the recited prior art into and modify the Zuser et al. invention would destroy the very essence of the

Zuser et al. invention. This is forbidden and has no basis or motivation in the record to do such. Yet that is exactly what the Examiner incorrectly attempted to do while ripping apart the core of the Zuser et al. invention. Zuser et al. discloses using an embossing procedure roll to simultaneously apply a sealing coating while embossing (roughening). Yet the Examiner threw out the coating function of the simultaneous coating and embossing step of Zuser et al. while reaching into the prior art section of Zuser et al. for a coating step before any embossing. The Examiner made this error in his above-recited misdescription of the Zuser et al. preparation process by trying to combine Zuser et al.'s described prior art, i.e., column 1, lines 10 to 22, with Zuser et al.'s invention, i.e., column 3, lines 10 to 18, while decapitating Zuser et al.'s invention by removing the coating function from the use of a embossing pressure roll to simultaneously coat and emboss a sealing layer. The Examiner has no factual and/or motivational basis for destroying the disclosed Zuser et al. invention in such manner.

The Office Action stated that Zuser et al. does not teach forming an embossed/roughened sealing layer using a textured cooling roll and a pressure/backing roll. That is not all that Zuser et al. does not disclose or suggest. Zuser et al. does not show a pressure/backing roll. Zuser et al. only discloses a pressure roll. It is not described as a backing roll. It is an embossing roll that is used to simultaneously coat and emboss a sealing layer. Zuser et al. does not mention a second roll, let alone a cold second roll. Zuser et al. does not even mention the concept of using a second roll, or a cold second roll. The Examiner has used forbidden hindsight incorrectly trying to ignore the express

teachings of Zuser et al. while rewriting the disclosure of Zuser et al. in the attempt to have it say that which it does not say in the pursuit of applicant's claimed process.

Hill does not cure the defects in Zuser et al. in the search for applicant's claimed invention.

The Office Action stated that, nonetheless, Hill teaches embossing an extrusion coating using textured cooling roll and a pressure/backing roll (1:64-2:20 and Fig. 1). Applicant traverses this statement as being an incorrect, incomplete description of the disclosed process of Hill. The one step process of Hill is the simultaneous coating and embossing a layer. The disclosure of Hill, like Zuser et al., directs one ordinarily skilled in the art away from applicant's two step process.

Both Zuser et al. and Hill have one step to simultaneously coat and emboss. The Examiner has no basis for trying to split the two simultaneous functions of such one-step process into two steps. To even try to do this would be mere speculation—both rejection references use one-step of simultaneous functions.

Note that Hill describes roll 16 as a steel backing roll, not a steel pressure/backing roll.

Hill runs paper through a nip formed by textured chill roll 14 and rubber roll 15. Resin is introduced into the nip on the side of the paper facing textured chill roll 14. Figure 1, cited by the Examiner, shows that the instance the resin is introduced into the nip, it contacts the paper and the surface of the texturized chill

roll 14, so it simultaneously is being roughened by filling in the textured surface with the instantaneous pressure applied by the nip, i.e., existing in the nip. Hill does have a backing roll 16 but it does not form a nip with its texturized chill roll 14. Hill's paper (substrate) and/or resin does not contact in any way with its pressure/backing roll 16, which is the opposite of Zuser et al.

The Office Action stated that, essentially, Hill suggests that a single station may be used to cool, emboss, and unite a substrate with a coating layer.

Applicant traverses this statement as being an unjustified attempt to generify the specific disclosure of Hill. Section 103(a) requires facts. Also, where does Hill essentially suggest that any of its disclosure can be generified? Hill is limited to a one-step process of simultaneously coating and embossing a layer using a textured chill roll opposed by a rubber roll behind which is a steel backing roll. No where does Hill suggest that any function can be removed from his one-step process.

The Office Action stated that Zuser et al. and Hill are combinable because they are concerned with a similar technical difficulty, namely, forming a texture upon a coated layer in a continuous process. Applicant traverses this statement. Just because two references are combinable is meaningless under Section 103(a). (This type of naked statement of combinability has been condemned by the patent court.) There must be some suggestion or motivation in the prior art that causes one ordinarily skilled in the art in the search for applicant's claimed invention. Applicant's disclosure cannot supply the necessary suggestion or motivation. Furthermore, the Examiner has no factual basis for trying to generify

the two specific separate problems of the two rejection references into a single, broad, overlying problem

Hill and Zuser et al. are not combinable.

The Examiner has not factually established a prima facie showing of obviousness in the record.

Throughout the Office Action the Examiner has ignored specific teachings of the two rejection references, tried to generify without factual support and justification, and has ignored the requirements of prior art suggestion or motivation.

The Office Action stated that, at the time of invention, a person having ordinary skill in the art would have found it obvious to have embossed an extrusion coating using a textured cooling roll and a pressure/backing roll, as taught by Hill, in the process of Zuser et al., and would have been motivated to do so in order to gain an economic benefit of remove a separate embossing station. Applicant traverses this statement. Hill and Zuser et al. are not combinable. Hill uses a textured chill roll, whereas Zuser et al. uses an embossing pressure roll. There is no motivation of record to put Hill's textured chill roll in Zuser et al. and throw out its embossing pressure roll. Zuser et al. only discloses the use of one roll, whereas Hill uses the two opposed rolls with a further non-contacting backing roll. The two systems are not the same and there is no teaching that one can be used in place of the other.

Hill states a backing roll, not pressure/backing roll.

Zuser et al.'s invention involves the simultaneous coating and embossing of a layer. Hill's invention involves the simultaneous coating and embossing of a layer. There is no required motivation or suggestion that would cause one skilled in the art to destroy the very core of the Zuser et al. invention or the Hill invention by destroying the simultaneous coating and embossing thereof by separating those two functions. In fact, the Examiner has agreed by saying that one ordinarily skilled in the art would be motivated to remove a separate embossing station.

Applicant's claimed invention involves separate steps of coating and embossing.

This rejection should be withdrawn.

The Office Action stated that, regarding Claims 13 to 16, Zuser et al. teaches a roughness of 1 to 100 um (1:50-64). Independent Claim 12 is not obvious over the two rejection references, so none of the dependent claims are obvious.

This rejection should be withdrawn.

Reconsideration, reexamination, and allowance of the claims are requested.

Respectfully submitted,

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Date

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